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In re Application of:	:	
NORDHOFF, Eckhard, et al.	:	DECISION ON RENEWED
U.S. Application No.: 10/576,644	:	REQUEST UNDER 37 CFR
Int'l Application No: PCT/EP2004/011878	:	1.497(d) AND PETITION FOR
Int'l Filing Date: 20 October 2004	:	REVIVAL UNDER
Priority Date: 23 October 2003	:	37 CFR 1.137(b)
Atty Docket No.: 39412.00.0002	:	
For: METHOD AND DEVICES FOR	:	
DEPOSITING SAMPLES ON AN	:	
ELECTRICALLY SHIELDED	:	
SUBSTRATE	:	

This decision is issued in response to the "Petition To Revive Unintentionally Abandoned Application Under 37 CFR 1.136(b)" filed 16 March 2009, and the renewed request to correct inventorship under 37 CFR 1.497(d) included therewith. Applicants have filed the petition fee required for the petition for revival; no additional fee is required with respect to the renewed request under 37 CFR 1.497(d).

BACKGROUND

The procedural background for the present application was set forth in the decision mailed on 08 May 2008. The decision dismissed without prejudice applicants' request under 37 CFR 1.497(d) to add four additional inventors to the present application. Specifically, the decision indicated that applicants had not provided the consent of the assignee required for such a request to be grantable, and that the filed declaration was an unacceptable compilation of multiple documents. The decision provided an extendable two-month period for applicants to file a request for reconsideration (accompanied by the additional required materials).

Applicants did not file a response to the 08 May 2008 decision during the available response period. Accordingly, the present application became abandoned as of midnight on 08 July 2008.

On 16 March 2009, applicants filed the petition for revival considered herein, accompanied by a renewed request to correct inventorship under 37 CFR 1.497(d) and a revised declaration.

DISCUSSION

1. Renewed Request To Correct Inventorship (37 CFR 1.497(d))

As noted above, applicants' previous request to add inventors under 37 CFR 1.497(d) did not include the consent of the assignee, as required by 37 CFR 1.497(d)(3). The present renewed request includes a "Declaration Of Scienion AG" executed by the CEO of Scienion AG ("Scienion"). This statement asserts that Scienion is the assignee of the invention herein and consents to the requested addition of the four inventors.

However, the assignee's consent must be submitted in compliance with 37 CFR 3.73(b) (see 37 CFR 1.497(d)(3); MPEP section 201.03(II)(D)). The "Declaration Of Scienion AG" filed by applicants here does not satisfy the requirements of 37 CFR 3.73(b)(1). Specifically, with respect to 3.73(b)(1), applicants have not provided a statement from the assignee that "the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation" or that "documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number)." Because the consent of the assignee has not been provided in compliance with the requirements of 37 CFR 3.73(b)(1), the "Declaration Of Scienion AG" filed here is not sufficient to satisfy the final requirement of a grantable request to correct inventorship under 37 CFR 1.497(d). The final element of a grantable request under 37 CFR 1.497(d) therefore remains unsatisfied.

Based on the above, the inventorship of record herein remains that set forth in the international application, that is, Eckhard NORDHOFF and Alan BULLOCK. Accordingly, the revised declaration filed with the present submission, which is executed by these two inventors and by the four proposed additional inventors (Christine LUBBERT, Antonin SCHENK, Holger EICHKOFF, and Martin HORN), is not acceptable on the present record because it does not name the proper inventive entity.

It is noted that the revised declaration is also defective in that it fails to include the citizenship of all the inventors, as required.

2. Petition For Revival (37 CFR 1.137(b))

37 CFR 1.137(b) permits the filing of a petition to revive an abandoned application where the abandonment resulted from an unintentional delay. A grantable petition under this section must include: (1) the required reply, unless previously filed; (2) the petition fee required by law; (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional;" and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c). The present petition does not satisfy item (1).

With respect to item (1), the "required reply" here is a proper response to the decision mailed on 08 May 2008, that is, the materials required to satisfy the final element of a grantable request under 37 CFR 1.497(d) to correct inventorship and an acceptable declaration executed by

the inventors. As discussed above, applicants' present submission does not include all the materials required to satisfy the final element of a grantable request under 37 CFR 1.497(d), and the declaration filed by applicants is also defective for failure to include the citizenship of all the inventors. Accordingly, applicants have not submitted the "required reply" and item (1) of a grantable petition for revival is therefore not satisfied.

CONCLUSION

The petition for revival under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

The renewed request to correct inventorship under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any request for reconsideration should be entitled "Renewed Petition Under 37 CFR 1.137(b) and Renewed Request Under 37 CFR 1.497(d)" and it must include the "required reply" necessary to satisfy item (1) of a grantable petition under 37 CFR 1.137(b), as discussed above. Specifically, applicants must submit: (1) the statement under 37 CFR 3.73(b) required to permit acceptance of the consent of the assignee to the requested change of inventorship,; and (2) complete copies of an acceptable declaration executed by the inventors of record that includes all required information, including the citizenship of each of the inventors.

No additional petition fees are required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration



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